

REMARKS

Status of Claims

Claims 1-22 are pending. Claims 1-22 have been rejected under 35 U.S.C. §103(a). Claims 1-22 remain for consideration upon entry of the present Response. No new matter has been added.

Claim Rejections – 35 U.S.C. §103(a)

Claims 1-9, 11-15, 17, 19, and 22 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,612,136 to Everaerts et al. (hereinafter "Everaerts '136") in view of U.S. Patent No. 5,695,837 to Everaerts et al. (hereinafter "Everaerts '837") as evidenced by U.S. Patent No. 5,611,881 to Kimura et al. (hereinafter "Kimura"). Claims 18 and 21 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Everaerts '136 in view of Everaerts '837 as applied to claim 12, further in view of U.S. Patent No. 5,264,278 to Mazurek et al. (hereinafter "Mazurek") as evidenced by Kimura. Claims 10 and 16 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Everaerts '136 in view of Everaerts '837 as applied to claims 1 and 12, further in view of U.S. Patent No. 5,521,227 to Palazzotto et al. (hereinafter "Palazzotto") as evidenced by Kimura. Claim 20 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Everaerts '136 in view of Everaerts '837 as applied to claim 12, further in view of Palazzotto and Mazurek as evidenced by Kimura.

Everaerts '136 discloses a pressure-sensitive adhesive having improved adhesion to acid-rain resistant automotive paints. The adhesive comprises a cross-linked copolymer comprising at least one monomer selected from the group consisting of monofunctional unsaturated meth(acrylate) esters, a nitrogen-containing basic monomer that is copolymerizable with the ester(s), an optional copolymerizable acidic monomer, and a cross-linking agent. (Column 3, line 49, to column 4, line 57).

Everaerts '837 discloses adhesives that are "acrylic polymers that are tackified with a water white, hydrogenated, aromatic hydrocarbon tackifying resin...." The acrylic polymer is the reaction product of at least one alkyl acrylate monomer and an optional monoethylenically unsaturated reinforcing co-monomer copolymerizable with the acrylate

monomer. The adhesive can be formulated to be a hot-melt adhesive and/or a heat-activated adhesive by any one of a variety of disclosed polymerization methods.

Kimura discloses a heat adhesive resin that includes a styrene/maleic anhydride copolymer, a styrene/acrylate copolymer, a styrene/methacrylate copolymer, polyvinyl acetate, a vinyl chloride/vinyl acetate copolymer, polyethylene, polypropylene, polyacetal, an ethylene/vinyl acetate copolymer, an ethylene/acrylate copolymer, an alpha-olefin/maleic anhydride copolymer, an esterification product of an alpha-olefin/maleic anhydride copolymer, polystyrene, polycaprolactone, polyacrylate, polymethacrylate, polyamide, an epoxy resin, a xylene resin, a ketone resin, a petroleum resin, sucrose ester, rosin or rosin derivatives, a coumarone-indene resin, a terpene resin, a polyurethane resin, synthetic rubbers such as styrene-butadiene rubber, polyvinyl butyral, nitrile rubber, acryl rubber and ethylene/propylene rubber, or a polyester resin.

Claim 1 recites an acrylic foam-like adhesive tape comprising at least one layer of a heat-activated adhesive disposed on at least one side of the backing, the heat-activated adhesive comprising a polyamide, a polyester, a polyolefin, a urethane, a polyurethane, a block copolymer, an elastomer, a block copolymer rubber, or a combination of the foregoing materials.

There is no teaching, suggestion, or motivation to combine the Everaerts references to arrive at the invention as recited in claim 1. As stated above, Everaerts '136 discloses a pressure-sensitive adhesive. Everaerts '837, on the other hand, discloses a heat-activated adhesive. Pressure-sensitive adhesives and heat-activated adhesives operate via distinct mechanisms. In particular, pressure-sensitive adhesives operate by the application of pressure, and heat-activated adhesives operate by the application of heat, pressure and heat being related insofar only as heat is a by-product of pressure. Because Everaerts '136 is a pressure-sensitive adhesive and because Everaerts '837 is a heat-activated adhesive, Everaerts '837 does not add to Everaerts '136 for purposes of teaching or suggesting the present invention. Furthermore, the recitation of Kimura, which merely discloses several types of heat adhesive resins, further fails to provide any suggestion or motivation for the combination of the pressure-sensitive adhesive of Everaerts '136 with the heat-activated adhesive of Everaerts '837. More specifically, one of skill in the art would not look to combining a pressure-sensitive adhesive with a heat-activated adhesive to arrive at the acrylic

foam-like adhesive tape comprising a heat-activated adhesive, as is claimed. Accordingly, there is no teaching, suggestion, or motivation to combine the Everaerts references to result in the invention as recited in claim 1.

Absent any teaching, suggestion, or motivation, to combine the references, such combinations are made by hindsight and are impermissible. Even if such combinations were possible, they would clearly not anticipate the invention or render the invention obvious. Accordingly, claims 1-9, 11-15, 17, 19, and 22 are patentable over the combination of the Everaerts references.

For at least the foregoing reasons, the combination of Everaerts '136 with Everaerts '837 does not teach, suggest, or motivate one to arrive at the invention as recited in claim 1. Thus, it is respectfully asserted that the combination of Everaerts '136 with Everaerts '837 is not proper prior art against the claimed invention under 35 U.S.C. §103 and that claim 1 is non-obvious.

Any claim that depends from a claim that is non-obvious is itself necessarily non-obvious. Claims 2-22, regardless of the art over which they are rejected, depend from claim 1, which is believed to be non-obvious. Because claims 2-22 depend from claim 1, and because claims that depend from a non-obvious claim are themselves non-obvious, claims 2-22 are necessarily non-obvious. Therefore, claims 2-22 are allowable. The rejection under 35 U.S.C. §103(a) should be withdrawn and claims 2-22 should be passed to issuance.

Conclusion

Applicants believe that the foregoing response fully complies with the Office Action and that the claims herein are allowable to Applicants. In view of the foregoing points that distinguish Applicants' invention from those of the prior art and render Applicants' invention novel and non-obvious, Applicants respectfully request that the Examiner reconsider the present application, remove the rejections, and allow the application to issue.

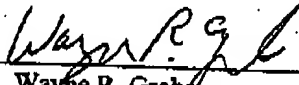
If the Examiner believes that a telephone conference with Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is invited to telephone the undersigned.

A check in the amount of \$1,190.00 is enclosed for the filing fee of the Request for Continued Examination (\$770) and the two-month extension fee (\$420). If additional

charges are incurred with respect to this Amendment, they may be charged to Deposit Account No. 13-0235 maintained by Applicants' attorneys.

Respectfully submitted,

By


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